

REMARKS

In accordance with the foregoing, the title and claims 76-80, 83, 84, 88-92, 96-99, 101, 105-108, 110, 112, 115, 118-122, 125, 129, 131, and 136-148 have been amended.

Claims 76-150 are pending and under consideration.

OATH AND DECLARATION:

In the Office Action, at page 2, it is contended that Applicants did not comply with the requirements of 37 CFR 1.63(c). Applicants respectfully traverse such contention. A copy of the declaration from parent application 09/084,323 was duly filed on April 16, 2001. A Preliminary Amendment was also filed on April 21, 2001 identifying that the present Application is a Continuation of application number 09/084,323 filed May 26, 1998. Accordingly, it is respectfully asserted that Applicants have complied with the requirements of 37 CFR 1.63(c).

OBJECTIONS TO THE DRAWINGS:

In the Office Action, at page 2, it is contended that the drawings are informal. A telephone call was conducted on April 21, 2004, between Examiner LaForgia and Applicant's representative. Examiner LaForgia recognized that formal drawings were submitted for the present application. Thus, reconsideration and withdrawal of the outstanding objections to the drawings are respectfully requested. It is respectfully asserted that the drawings for the present application are formal and in compliance with current Patent rules and procedures.

OBJECTION TO THE TITLE:

In the Office Action, at page 2, the title was objected to as not being descriptive. In view of the proposed amended title set forth above, the outstanding objection to the title should be resolved.

FOREIGN PRIORITY BENEFIT:

Foreign priority benefit under 35 U.S.C. § 119 was claimed on April 16, 2001 to Japanese Application No. 9-264839, filed September 10, 1997 and Japanese Application No. 10-94592, filed April 7, 1998. A certified copy of the priority document was filed in the parent application U.S. Serial No. 09/348,166 76 with Examiner Jeffrey S. Leaning in Group/Art unit No. 2131.

Further, on January 28, 2004, Applicants' representative conducted a telephone conference with Examiner LaForgia and explained to him that according to the rule, since we submitted the acknowledgment in the application transmittal sheet, we do not need to provide the same information in the declaration. Examiner LaForgia explained that he must have overlooked the transmittal sheet and that, accordingly, we may consider the application in compliance with the rule and no further action is required.

Applicants respectfully request that the foreign priority benefit be considered and acknowledged.

REJECTION UNDER DOUBLE PATENTING:

Claims 76-150 are pending and under consideration. Please find enclosed herewith a Terminal Disclaimer to address, without prejudice, the Examiner's provisional rejections of the claims under the judicially created doctrine of obviousness-type double patenting. In view of the enclosed Terminal Disclaimer, it is respectfully requested that the Examiner reconsider and withdraw the provisional rejection of claims 76-150.

REJECTION UNDER 35 U.S.C. § 102:

In the Office Action, at page 3, claims 76, 78, 80, 81, 84, 85, 87, 88, 90, 91, 93, 94, 97, 98, 100, 105, 107, 108, 110, 111, 114, 115, 117-121, 123, 124, 125, 127, 129, 136, and 142-150 are rejected under 35 U.S.C. § 102 in view of U.S. Patent No. 5,970,146 to McCall et al. ("McCall"). This rejection is traversed and reconsideration is requested.

McCall generally describes a data encrypted touch screen that is used to input a personal identification number (PIN). See column 4, lines 21-43. The touch screen is coupled to an epoxy mass in which a touch screen controller, a system controller, and a data encryption

(DES) module are embedded.

However, McCall fails to teach or suggest, "a specifying member which is placed on the touch sensor and specifies a plurality of discontinuous different coordinates," as recited in independent claims 76, 88, 105, 118-121, 125, 129, 142, 145, and 148. Rather, once a card is read, a video keypay image 26a is displayed, the PIN is entered, and the PIN is processed and exchanged between the DES module 18 and the system controller 16. Nothing in McCall teaches or suggests the recitations of the specifying member of the presently claimed invention.

Accordingly, in view of the foregoing, it is respectfully requested that independent claims 76, 88, 105, 118-121, 125, 129, 142, 145, and 148 and related dependent claims be allowed.

REJECTION UNDER 35 U.S.C. § 103:

In the Office Action, at page 6, claims 77, 89, 106, 122, and 137-141 are rejected under 35 U.S.C. § 103 in view of U.S. Patent No. 4,656,662 to Filliman et al. ("Filliman"). This rejection is traversed and reconsideration is requested.

Filliman generally describes a personal identification method and apparatus, employing a combination of a CRT and a light pen by movement of the light pen on the CRT. See column 3, lines 4-16. A process generates a series of short vectors and enables a division of an XY coordinate system into eight zones or octants. See column 7, lines 30-62.

However, Filliman fails to teach or suggest, "a specifying member which is placed on the touch sensor and specifies a plurality of discontinuous different coordinates," as recited in independent claims 77, 89, 106, 122, and 137. Also, Filliman fails to teach or suggest, "a specifying member which is placed on the coordinate detector, said specifying member being independent of a detecting unit and specifying a plurality of discontinuous different coordinates," as recited in independent claims 138-141. Rather, an identification method is generally described capturing positional information and storing a mathematical representation thereof for future reference. Nothing in Filliman teaches or suggests the recitations of the specifying member of the presently claimed invention.

Accordingly, in view of the foregoing, it is respectfully requested that independent claims 77, 89, 106, 122, and 137-141 and related dependent claims be allowed.

In the Office Action, at page 8, claims 79, 82, 83, 86, 92, 95, 96, 99, 109, 112, 113, 116,

and 126 are rejected under 35 U.S.C. § 103 in view of U.S. Patent No. 5,970,146 to McCall et al. ("McCall"). This rejection is traversed and reconsideration is requested.

The arguments presented above are incorporated herein to support the patentability of claims 79/76, 82/76, 83/76, 86/76, 92/88, 95/88, 96/88, 99/88, 109/105, 112/105, 113/105, 116/105, and 126/121 over McCall.

Accordingly, it is respectfully requested that claims 79, 82, 83, 86, 92, 95, 96, 99, 109, 112, 113, 116, and 126 be allowed.

In the Office Action, at page 10, claims 130-135 are rejected under 35 U.S.C. § 103 in view of U.S. Patent No. 5,970,146 to McCall et al. ("McCall") and further in view of U.S. Patent No. 4,656,662 to Filliman et al. ("Filliman"). This rejection is traversed and reconsideration is requested.

The arguments presented above are incorporated herein to support the patentability of claims 130-131/76, 132/77, 133/89, 134/106, and 135/122 over McCall and Filliman.

Accordingly, it is respectfully requested that claims 130-135 be allowed.

In the Office Action, at page 12, claims 101-104 are rejected under 35 U.S.C. § 103 in view of U.S. Patent No. 3,304,411 to Blodgett ("Blodgett"). This rejection is traversed and reconsideration is requested.

Blodgett generally describes a punched-card reader for reading positions of punched holes in punched-cards. See column 2, lines 34-62. However, nothing in Blodgett teaches or suggests, "a user authentication card which is **placed on the touch sensor** when inputting a plurality of discontinuous different coordinates for user authentication," emphasis added, as recited in independent claim 101.

Further, as correctly recognized in the Office Action, Blodgett fails to teach or suggest, "a plurality of perforated parts, each of perforated parts removed by punching forming a hole which is used when inputting the plurality of discontinuous different coordinates to the touch sensor," as recited in independent claim 101.

One of the many benefits of the perforated parts in the card is to allow the user to easily form the holes at arbitrary perforated parts, without the need to use a special punching machine.

Furthermore, as commonly understood, the Examiner bears the burden of establishing a

prima facie case of obviousness based upon the prior art..."[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84.

However, the Examiner has provided absolutely no motivation to arrive to the presently claimed invention. Rather, conclusive statements are made such as "it would have been obvious to an artisan of ordinary skill in the art . . . to provide for perforated sections to be punch out, as it would make the act of punching out the parts more effective and easier to accomplish," and that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for a direction as to how to insert the card, as it would prevent misreads of the card."

"Rejection of patent application for obviousness under 35 USC §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

Only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken this teaching of the present invention and applied the same to Blodgett, as set forth in the Office Action, to disclose the presently claimed invention. Applicants respectfully assert that the prima facie burden has not been met.

Accordingly, in view of the foregoing, it is respectfully requested that independent claim 101 and related dependent claims be allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

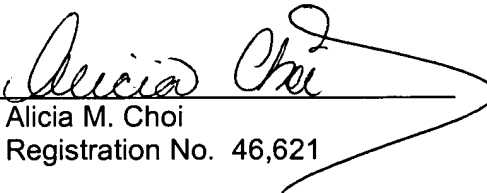
If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner's contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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